

REMARKS

Claims 15-17 have been amended to adopt a suggestion made by the Examiner to resolve an issue under 35 U.S.C. 112, first paragraph.

Entry of the above amendment is respectfully requested.

Provisional Application

On page 2 of the Office Action, the Examiner indicates that an English translation of the non-English language provisional application and a statement that the translation is accurate are missing, so Applicant must supply 1) the missing English translation and a statement that the translation is accurate in provisional application No. 60/363,102 and 2) in the present application, a confirmation that the translation and statement were filed in the provisional application.

In response, Applicants note that an English translation of the non-English language provisional application and a statement that the translation is accurate were in fact filed in the provisional but apparently were lost, so Applicants are submitting copies in the provisional with a filing receipt date-stamped by the PTO, and are submitting herewith a copy of the electronic filing receipt as confirmation in the present application that the translation and statement were filed in the provisional application.

Reference to PCT Application

On page 3 of the Office Action, the Examiner indicates that this application appears to claim subject matter disclosed in prior Application No. PCT/JP03/02646, filed March 6, 2003, so

a reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if Applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c).

In response, Applicants note that the present application is simply the national stage of PCT/JP03/02646, and thus no reference to the PCT application needs to be inserted as the first sentence of the specification (see MPEP 1893.03(c)III., particularly the sentence bridging the left and right columns on page 1800-208 in MPEP Rev. 7, July 2008). Rather, only a reference to the provisional application needs to be included in the first sentence of the specification, and such is already included. Nevertheless, to expedite allowance, we have amended the first sentence of the specification to include a reference to the PCT application.

Rejection under 35 U.S.C. 112, First Paragraph

On page 4 of the Office Action, claims 15-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reducing the amount of pigmentation of the skin, does not reasonably provide enablement for prevention of pigmentation of the skin.

In particular, the Examiner indicates that the working examples support "reducing" the amount of pigmentation. Thus, the Examiner suggests deleting the term "preventing" and reciting "reducing" instead.

In view of the Examiner's indication, and to expedite allowance, Applicants have amended claims 15-17 to change "preventing" to "reducing" as suggested by the Examiner.

Thus, Applicants submit that the present claims satisfy the requirements of 35 U.S.C. 112, first paragraph, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Takata et al

On page 6 of the Office Action, claims 2-3, 7-8, and 11-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Takata et al. (Journal of Lipid Research, 2002, 43, pages 2196-2204).

In response, Applicants note that the present application claims the benefit of U.S. Provisional Application No. 60/363,102 filed March 12, 2002, which is prior to the September, 2002 publication date of Takata et al., and that claims 2, 3, 7, 8, and 11-14 are supported by the disclosure of that provisional application. Accordingly, Applicants submit that the claimed invention antedates Takata et al., and thus Takata et al. cannot be relied upon as prior art to reject the claimed invention.

Therefore, Applicants submit that the present invention is not anticipated by Takata et al., and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Weber et al in view of Takata et al

On page 7 of the Office Action, claims 2-3 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (Free Rad. & Med., 1997, 22(5), pages 761-769) in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100).

In response, Applicants submit initially that Weber et al. fails to disclose the use of acetate derivatives of tocopherol (if the Examiner wishes to maintain his position, he is requested

to quote the disclosure being relied upon, because Applicants do not see any acetate derivatives of tocopherol at page 767, paragraph [2], lines 1-7, contrary to the Examiner's indication in the middle of page 7 of the Office Action). That is, Applicants submit that there is no overlap between Weber et al. and Takata et al. Therefore, a person skilled in the art would not have been motivated to combine the disclosure of Weber et al. and Takata et al.

Furthermore, in the response to the previous Office Action, the overlap in the scope of a compound between the present invention and Takata et al. was deleted from the claims; therefore, a composition of the present invention as recited in the claims is not taught or suggested even if Weber et al. and Takata et al. are combined.

Thus, Applicants submit that the present invention is not obvious over Weber et al. in view of Takata et al., and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Weber et al in view of Takata et al, further in view of Yasuaki

On page 8 of the Office Action, claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (Free Rad. & Med., 1997, 22(5), pages 761-769) in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100) as applied to claim 2 above, and further in view of Yasuaki (JP 62-106005).

In response, Applicants submit that Yasuaki does not make up for the deficiency of Weber et al. in view of Takata et al. as discussed above in regard to the preceding rejection, so Applicants submit that the combination of Weber in view of Takata and further in view of Yasuaki neither teaches nor suggests the present invention.

Further, Applicants note that Weber et al. is directed to coping with oxidative injury by UV irradiation. It is not directed to whitening of the skin. Oxidative injury is not the same as whitening of the skin.

Therefore, Applicants submit that the present invention is not obvious over Weber et al. in view of Takata et al. and further in view of Yasuaki. Accordingly, withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Burke et al in view of Takata et al

On page 8 of the Office Action, claims 2-3 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. (Nutrition and Cancer, 2000, 38(1), pages 87-97) in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100).

In response, Applicants submit that Burke et al. specifically teaches the use of α -tocopheryl acetate (third line of the abstract), and teaches away from the use of the β , γ , and δ forms by disclosing in the second column on page 87 that those forms have only a fraction of the protection against post-UV edema relative to the α -form. Accordingly, Applicants submit that if one were to combine Burke et al. with Takata et al., one would have used the α -form, which is specifically excluded from the claimed invention (wherein derivatives in which R₃, R₄, and R₅ represent methyl at the same time are not included in the claimed invention), and thus the present invention is not obvious over the cited art.

That is, Burke et al. specifically describes in the second column on page 87:

"The purpose of this study was to determine whether topical RRR- α -tocopherol (Eol), topical RRR- α -tocopheryl succinate (Esucc), or oral RRR- α -tocopheryl acetate (Eac) can reduce

acute and chronic UV radiation-induced damage to the skin. ... Relative to the α -form, the β -, γ -, and δ -RRR-tocopherols have only 42%, 72%, and 40%, respectively, of the protection against post-UV edema".

Therefore, Applicants submit that Burke et al. teaches away from the β , γ , and δ forms of tocopherol, and a person skilled in the art would not have been motivated to combine the disclosure of this reference with that of Takata et al. to arrive at the present invention.

Thus, Applicants submit that the present invention is not obvious over Burke et al. in view of Takata et al., and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: April 22, 2009

Respectfully submitted,



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Electronic Acknowledgement Receipt

EFS ID:	5201511
Application Number:	60363102
International Application Number:	
Confirmation Number:	4386
Title of Invention:	Skin preparation for external application
First Named Inventor/Applicant Name:	Eiko Kato
Customer Number:	23373
Filer:	Abraham Jacob Rosner/Vanessa Ward
Filer Authorized By:	Abraham Jacob Rosner
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Application Type:	Provisional

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1		Sub_Eng_Translation.pdf	3440001 a4027ebd518640b34c454e333c99627a1e37abaf1e	yes	33

Multipart Description/PDF files in .zip description		
Document Description	Start	End
Miscellaneous Incoming Letter	1	4
Specification	5	33

Warnings:

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 If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

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New International Application Filed with the USPTO as a Receiving Office
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